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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,523	04/18/2001	Claude Debroche	34213-071556.0172	8187
27799	7590	01/24/2005	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			KNABLE, GEOFFREY L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,523

Applicant(s)

DEBROCHE, CLAUDE

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 12-17 is/are allowed.
- 6) ☒ Claim(s) 10,11,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. Claims 10, 11, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained for the reasons set forth in the last office action.

With respect to this rejection, applicant first argues that the specification examples have a greater disk speed and that a specification may "contain a written description of a broadly claimed invention without describing all species that the claims encompass", citation being made to the Cordin Corp. decision. This argument has been carefully considered but is unpersuasive. In particular, while it is not disputed that all species must not be described if a genus claim is presented, at issue here is whether there is sufficient evidence to conclude that the now broadly claimed invention is described/possessed. Lacking any original literal disclosure supporting the claim language, the only possible support for this language can come from the examples. However, there are only two very specific examples and importantly *no* indication or characterization of the invention with respect to these examples as having anything to do with the now claimed relative speeds. While it is possible to derive what these relative speeds would be, now recharacterizing the invention as including a specific defined relationship between these relative speeds is considered to go beyond the original disclosure when there is no indication that these specific relative speeds were even contemplated as a characterizing feature of the invention in the original disclosure.

The two specific examples, which are not described in terms of the now claimed speed relationship, is not sufficient evidence to conclude that applicant possessed the invention as now claimed.

Applicant also urges that the examiner "admits that the specification discloses the knife supporting disk rotating faster than the input shaft." To be precise, the examiner indicated that after an examination of the described embodiments, the knife disk in these embodiments is rotating at a certain degree faster than the input shaft. Thus, the specification never actually "discloses" one rotating faster than the other but rather simply particular embodiments for which a certain relationship can be derived. Importantly, again, however, there is no express characterizing of the invention in the original disclosure as being related to any particular relationship between the now claimed speeds.

Applicant also urges that the discussion of gear reduction ratios in the specification supports the more broadly defined speed ratios. This argument has been carefully considered but is unpersuasive. While the specification does indicate that the gear reduction ratio is chosen so that the knife is presented every certain number of turns of the carrier 47, it is still not seen why this would show possession of the invention as characterized in the noted claims. In fact, the description in paragraph [0022] that on each turn of the carrier 47, the "knife can describe several turns" would argue even further against the broadly claimed speed ratio being described/possessed. In other words, the invention as characterized in the noted claims would include the knife only turning slightly faster than the shaft and thus it would clearly *not* describe

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several turns for each shaft turn in such instance. Thus, again, there is simply no indication of possession of the invention as defined in the noted claims.

It is also urged that the specification does not provide any specific limitations on the relative rotational speeds to exclude ratios below 2.33. The specification however does not discuss these ratios at all and thus cannot be said to have any requirements in this regard.

With respect to claim 11, it is argued that embodiments of 2.33 and 2.5 support a range of greater than 2. However, again, there is no indication or characterization of the invention as pertaining to the specific range claimed and it thus is not considered that this is described in a manner that would evidence possession of this broader range (which range further includes many embodiments well outside (both above and below) the original descriptive support provided by these derived numbers from the examples). The reference to paragraph [0008] and the every "n" passage, n being greater than 2, is noted but it is not clear how this reference to a range for a separate and distinct variable shows possession of the relative speeds ranges claimed.

As to claim 18, it is argued that paragraph [0008] of the summary of invention refers to the knife being active every "n" passes, n being greater than or equal to two, it being urged that this description is not specific to any particular embodiment. This argument has been considered but is unpersuasive as paragraph [0008] prefaces the reference to "n" with "As a variant, the design of the control is such that..." It is submitted that this would have been reasonably read as only referring to the *specific variant* described where this *specific* control is mentioned, this not including the fig. 5-6

embodiment. Thus, again, it is submitted that the figs. 5-6 embodiment cannot be reasonably considered to be originally described or characterized in any manner relative to the number of passes, etc. As such, claim 9 is not considered to be generic to the figs. 5-6 embodiment and thus again new claims 18 and 19, that are directed and limited to the figs. 5-6 embodiment but are also dependent upon claim 9, are considered to newly describe the invention in a manner that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

2. Claims 9 and 12-17 are allowed over the closest prior art for the reasons advanced by applicant in the 2-24-04 response.
3. Applicant's arguments filed 10-1-2004 have been fully considered but they are not persuasive for the reasons noted above.
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

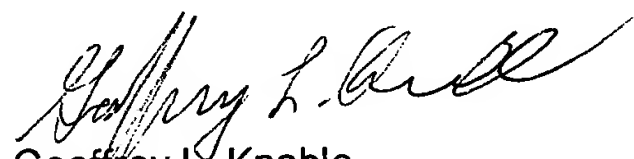
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
January 22, 2005